

**This Page is Inserted by IFW Indexing and Scanning
Operations and is not part of the Official Record**

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- ☐ **BLACK BORDERS**
- ☐ **IMAGE CUT OFF AT TOP, BOTTOM OR SIDES**
- ☐ **FADED TEXT OR DRAWING**
- ☐ **BLURRED OR ILLEGIBLE TEXT OR DRAWING**
- ☐ **SKEWED/SLANTED IMAGES**
- ☐ **COLOR OR BLACK AND WHITE PHOTOGRAPHS**
- ☐ **GRAY SCALE DOCUMENTS**
- ☐ **LINES OR MARKS ON ORIGINAL DOCUMENT**
- ☐ **REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY**
- ☐ **OTHER:** _____

IMAGES ARE BEST AVAILABLE COPY.

As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/774,379	01/30/2001	Kenzo Tsuji	9448-109US (G0196US)	2582

570 7590 08/31/2004

AKIN GUMP STRAUSS HAUER & FELD L.L.P.
ONE COMMERCE SQUARE
2005 MARKET STREET, SUITE 2200
PHILADELPHIA, PA 19103-7013

EXAMINER

CHANG, KENT WU

ART UNIT

PAPER NUMBER

2673

DATE MAILED: 08/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/774,379

Applicant(s)

TSUJI ET AL.

Examiner

Kent Chang

Art Unit

2673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/18/01.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 6/18/01 is in compliance with the provisions of 37 CFR 1.97 and all of the references listed in the IDS have been considered by the examiner.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 1 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Flickinger et al (US Patent No. 5,629,499).

Flickinger teaches an electronic-form preparation system comprising: an input pen including a writing member for handwriting characters into a form having a predetermined format, and a transmitter provided in the vicinity of a tip of said writing member for emitting a signal when making entries into said form by said input pen is started; a coordinate-input device including a plurality of receivers spaced from each other and receiving said signal emitted from said transmitter, and a signal processing circuit for determining coordinates of a series of points constituting a part of a locus of a character handwritten into said form

Art Unit: 2673

by said input pen on the basis of timing of reception of said signal by each of said receivers; and a data processor including electronic-form data generator for generating data of an electronic form on the basis of said coordinates supplied from said coordinate-input device (column 2 line 27 to column 3 line 3, column 3 line 43 to column 4 line 2).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flickinger et al (US Patent No. 5,629,499) in view of Carini et al (US Patent No. 6,456,740).

Flickinger teaches an electronic-form preparation system comprising: an input pen including a writing member for handwriting characters into a form having a predetermined format, and a transmitter provided in the vicinity of a tip of said writing member for emitting a signal when making entries into said form by said input pen is started; a coordinate-input device including a plurality of receivers spaced from each other and receiving said signal emitted from said transmitter, and a signal processing circuit for determining coordinates of a series of points constituting a part of a locus of a character handwritten into said form

Art Unit: 2673

by said input pen on the basis of timing of reception of said signal by each of said receivers; and a data processor including electronic-form data generator for generating data of an electronic form on the basis of said coordinates supplied from said coordinate-input device (column 2 line 27 to column 3 line 3, column 3 line 43 to column 4 line 2). Flickinger uses form identifier such as a number, bar code for identifying the form type, but does not show a character recognition unit for entering the form type by the user.

However, Carini teaches to use a data processor including character-recognition unit for recognizing the character handwritten into the form by an input pen on the basis of a coordinates supplied from said coordinate-input device, in which said data processor further includes: identifying-character registration unit for registering identifying characters used for identifying form types, form-format registration unit for registering format for each of said form types; and form-type determining unit for determining a form type of said form by comparing an identifying character which has been entered into a predetermined area in said form by said input pen and identified by said character-recognition unit with said identifying characters registered in said identifying-character registration unit; said character-recognition unit reading, from said form-format registration unit, a form-format of an electronic form corresponding to said form whose form type has been determined by said form-type determining unit, and recognizing characters entered into areas other than said predetermined area of said form on the basis of said form-format read from said form-format registration unit; said electronic-form

Art Unit: 2673

data generating unit generating data of an electronic form corresponding to said form whose form type has been determined by said form-type determining unit (column 4 line 1 to column 5 line 53). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to use character-recognition unit as taught by Carini in the device of Flickinger so as to reduce system component cost and makes the identification step a natural part of the form-filling process as suggested by Carini (column 2 lines 1-7).

6. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flickinger et al (US Patent No. 5,629,499) in view of Ishikawa et al (US Patent No. 5,750,941).

Flickinger teaches an electronic-form preparation system comprising: an input pen including a writing member for handwriting characters into a form having a predetermined format, and a transmitter provided in the vicinity of a tip of said writing member for emitting a signal when making entries into said form by said input pen is started; a coordinate-input device including a plurality of receivers spaced from each other and receiving said signal emitted from said transmitter, and a signal processing circuit for determining coordinates of a series of points constituting a part of a locus of a character handwritten into said form by said input pen on the basis of timing of reception of said signal by each of said receivers; and a data processor including electronic-form data generator for generating data of an electronic form on the basis of said coordinates

Art Unit: 2673

supplied from said coordinate-input device (column 2 line 27 to column 3 line 3, column 3 line 43 to column 4 line 2). Flickinger does not show an ultrasonic emitter with three receivers.

However, Ishikawa teaches to use a coordinate input device having a Transmitter (1) including an ultrasonic oscillator and three receivers (3a-3e) for inputting coordinate data to a computer (see Figure 6 and the corresponding description). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to use a coordinate input device having a transmitter including an ultrasonic oscillator and three receivers as taught by Ishikawa in the device of Flickinger so as to provide coordinate data to a computer with high accuracy and low cost. Moreover, it would have been obvious for one of ordinary skill in the art at the time of the invention to use any well known method such as using hyperbolic curve determining method in calculating the position of the stylus from the input data since any well known method would perform equally well in calculating the position of the stylus.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Comerford et al (US Patent No. 5,243,149); Belville et al (US Patent No. 5,734,129); Reid-Green (US Patent No. 5,869,789); Xu (US Patent No. 6,535,206); Van Sickle et al (us p6,707,466); Xu (US Patent No. 6,717,073).

Art Unit: 2673

CONTACT INFORMATION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kent Chang whose telephone number is 703-305-4824. The examiner can normally be reached on Monday to Thursday from 9:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala, can be reached at 703-305-4938.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

703-872-9306

Hand-delivered responses should be brought to Crystal Park II, 2121

Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR

Art Unit: 2673

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kent Chang
Primary Examiner
Art Unit 2673

kc

8/24/04